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In re Application of: SCHUTZE, Francois, et al. :	
U.S. Application No.: 10/532,114	:
PCT No.: PCT/FR2003/003124	:
International Filing Date: 21 October 2003	:
Priority Date: 21 October 2002	:
Attorney Docket No.: 1032013-000119	:
For: PHARMACEUTICAL	:
COMPOSITION COMBINING	:
TEATOPRAZOLE AND A	:
HISTAMINE H2-RECEPTOR	:
ANTAGONIST	:

DECISION REGARDING
SUBMISSION UNDER
37 CFR 1.42

This communication is issued in response to applicants' submission on 03 April 2006 of a declaration executed on behalf of deceased inventor Alain TACCOEN by his heir and legal representative Nathalie TACCOEN, which has been treated as a submission under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 21 October 2003, applicants filed international application PCT/FR2003/003124. The application claimed a priority date of 21 October 2002 and designated the United States. On 06 May 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 21 April 2005.

On 21 April 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and an English translation of the international application.

On 07 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration acceptable under 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 03 April 2006, applicants filed a response to the Notification Of Missing Requirements that included payment of the required surcharge and a declaration executed by the surviving inventors and on behalf of deceased inventor Alain TACCOEN by his heir and legal

representative Nathalie TACCOEN. This declaration is considered below under 37 CFR 1.42 and 1.497.

DISCUSSION

37 CFR 1.42 states in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

37 CFR 1.497(b)(2) states:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the declaration must provide the citizenship, mailing address, and residence information for the legal representative **and** the name and citizenship of the deceased inventor. Here, the filed declaration does not comply with 37 CFR 1.497(b)(2) in that it does not provide separate citizenship information for the deceased inventor.

In addition, the declaration filed 03 April 2006 (which consists of one copy of pages “1” and “2” and two different copies of page “3”) appears to be a compilation of two separately executed declarations, and as such is not acceptable under 37 CFR 1.497. See MPEP § 201.03(II)(B): “Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.”

Because the filed declaration does not include all the information required by 37 CFR 1.497(b)(2) and appears to be a compilation of multiple declarations, the declaration cannot be accepted under 37 CFR 1.42 and 37 CFR 1.497.

CONCLUSION

The 03 April 2006 submission under 37 CFR 1.42 is **REJECTED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mail date this communication to submit a proper response under 37 CFR 1.42 and 1.497. Failure to file a proper and timely response will result in abandonment. Extensions of time are available under 37 CFR 1.136(a).

A proper response must include an oath or declaration executed on behalf of the deceased inventor by his legal representative and containing all the information required under 37 CFR 1.497, including, as discussed above, the citizenship, residence, and mailing address of the legal representative and the name and citizenship of the deceased inventor. Applicants must also provide complete copies of the declarations executed by the surviving inventors (rather than the compilation filed 03 April 2006).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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